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| EXAMINER | |
|---|---|
| TSUI, WILSON W | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/777,046 | LERNER ET AL. | |
| | Examiner | Art Unit | |
| | WILSON TSUI | 2178 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *19 December 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *5-7,9,10,13,15,16,19,21 and 23-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *5-7,9,10,13,15,16,19,21 and 23-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

1. This non-final action is in response to the amendment filed on: 12/19/08.

2. Claims 1, 3, 4, 8, 11, 12, 14, 17, 18, 20, and 22 are cancelled. Claims 5, 6, 7, 9, 10, 13, 15, 16, 19, 21, and 23 - 26 are pending. Claims 9, 13, 15, 19, 21, and 23 are independent claims.

3. Upon further consideration of references used in previous rejection, and new reference(s) found in an updated search, the following rejections are withdrawn:

- Claim 2 rejected under 35 U.S.C. 103(a) as being unpatentable over Price et al, Schilit et al, and Wilcox et al, in further view of Schilit et al
- Claims 5-7, and 21-25 rejected under 35 U.S.C. 103(a) as being unpatentable over Price et al, and Schilit et al, in further view of Wilcox et al.
- Claims 9, 10, 15, and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Price et al, and Schilit et al, in further view of Madduri).
- Claims 13, and 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Price et al (US Patent: 6,766,494 B1, issued: Jul. 20, 2004, filed: Jun. 15, 1998), in view of Schilit et al (US Patent: 6,687,876, issued: Feb. 3, 2004, filed: Dec. 30, 1998).
- Claim 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Price et al, Schilit et al, and Wilcox et al, in further view of Madduri et al.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 5, 6, 7, 9, 10, 13, 15, 16, 19, 21, and 23 - 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Keely et al (US Application: US 2002/0049787, published: Apr. 25, 2002, filed: Dec. 29, 2000).

With regards to claim 9, Keely et al teaches a method of displaying clips comprising the steps of:

*receiving at least two sets of an annotation and related content, the at least two sets being from non-contiguous portions of a document or portions of different documents* (Figure 13: whereas a plurality of sets of annotations can be received)*;*

*combining said at least two sets to form a combination consisting of non-contiguous portions of a document or portions of different documents or both; filtering said combination of said at least two sets* (paragraph 0015, 0016, 0075, and 0078, Figure 9: whereas, clips comprise annotations that are filtered per user input, and the clips can comprise a combination of two or more filtered annotations)*;*

*; and displaying the filtered combination of said at least two sets* (paragraph 0078, Figure 9: whereas, the clips are rendered for display)*.*

With regards to claim 10, which depends on claim 9, Keely et al teaches further

comprising the step of*: storing said combination of said at least two sets* (Figure 8A, Figure 8B: whereas storage is implemented).

With regards to claim 13, Keely et al teaches a method of storing and accessing clips comprising the steps of:

*receiving data regarding an annotation* (Figure 1B, reference 170: whereas a stylus can be used for a method of input)*, and the data will include a user interface to allow various selections of active* content *change when since the previous session the active content has changed* (paragraph 0012: whereas, the content of the document can change/modifiable)*, storing a link to context information with said annotation data in storage; storing associations regarding at least two documents from which said annotation originates* (Figure 8A, Figure 8B: whereas storage is implemented)*, wherein selection of said annotation accesses the at least two documents to display said annotation based on the active content selection portions* (paragraph 0015, 0016, 0062, 0075, and 0078, Figure 9: whereas, for a plurality of documents/pages, clips comprise annotations that are filtered per user input, and the clips can comprise a combination of two or more filtered annotations ).

With regards to claim 15, Keely et al teaches a computer-readable medium having a program stored thereon, said program for displaying clips and comprising the steps of:

*receiving at least two sets of an annotation* (Figure 13: whereas a plurality of sets of annotations can be received) *and related content and the associated content will*

*include a user interface to allow various selections active* content *change when since the previous renderable image upon the user interface, the active content associated with the annotation has changed* (paragraph 0012: whereas, the content of the document can change/modifiable)*;*
*combining said at least two sets to form a combination consisting of non-contiguous portions of a document or portions of different documents or both; filtering said combination of said at least two sets based on the active content selection and displaying the filtered combination of said at least two sets* (paragraph 0015, 0016, 0075, and 0078, Figure 9: whereas, clips comprise annotations that are filtered per user input, and the clips can comprise a combination of two or more filtered annotations).

With regards to claim 16, which depends on claim 15, Keely et al teaches further comprising the step of: *storing said combination of said at least two sets* (Figure 8A, Figure 8B: whereas storage is implemented)..

With regards to claim 19, which depends on Keely et al teaches a computer-readable medium having a program stored thereon, said program for storing and accessing clips and comprising the steps of:
*receiving data regarding an annotation, the at least two sets being from non-contiguous portions of a document or portions of different documents* (Figure 13: whereas a plurality of sets of annotations can be received) *and the data will include a user interface to allow various selections active content change when since the previous*

*session the active content has changed* (paragraph 0012: whereas, the content of the document can change/modifiable);

*storing a link to context information with said annotation data in a storage* (Figure 8A, Figure 8B: whereas storage is implemented)*;*

*storing associations regarding at least two documents from which said annotation originates, wherein selection of said annotation accesses the at least two documents to display said annotation based on the active content selection* (paragraph 0015, 0016, 0062, 0075, and 0078, Figure 9: whereas, for a plurality of documents/pages, clips comprise annotations that are filtered per user input, and the clips can comprise a combination of two or more filtered annotations).

With regards to claim 21. Keely et al teaches a system for showing clips of content and annotations comprising:

*an input for receiving a plurality of annotations, each annotation is associated with a specific content portion of the document being annotated* (Figure 1B, reference 170: whereas a stylus can be used for a method of input)*;*

*the specific content portions having active content within the document that is non-static* (paragraph 0012: whereas, the content of the document can change/modifiable), the *active-content is maintained by downloading current active content to a local stored copy* (paragraph 0040: whereas, the active content can be downloaded to the local memory of a handheld device).

*a processor executing instructions from a computer readable medium;*

*the processor producing a subset of annotations by filtering annotations using user specified filtering criteria, said filtering criteria including performing handwriting recognition on annotations to determine when annotations contain text, the text is searched to filter the one or more clips* (paragraph 0010, 0089: whereas handwriting recognition is performed on annotations, and the annotations can be filtered per user input)*;*

*the processor creating a renderable image having clips, wherein at least one of said clips comprises an annotation from the subset with the associated specific content portion of the subset, and at least one of said clips comprises a combination of two or more filtered annotations from the subset, with their associated content portions* (paragraph 0015, 0016, 0075, and 0078, Figure 9: whereas, clips comprise annotations that are filtered per user input, and the clips can comprise a combination of two or more filtered annotations )*;*

*wherein the processor creating the combination by:*

*encompassing a first content and an associated annotation from the subset in a first bounding box* (paragraph 0091: whereas an asterisk annotation, is associated with a region of content)*,*

*encompassing second content and an associated annotation from the subset in a second bounding box, wherein the first and second bounding boxes are non-contiguous* (paragraph 0092, Figure 13: whereas another type of annotation/ink is associated with another region of content, the first and second regions of content can be non-

contiguous)*; calculating distance determinations between the first and second bounding boxes, and determining that when the bounding boxes are within a short threshold distance from each other, the bounding boxes are identified for grouping and combining; combining the first bounding box and the second bounding box to produce the clip containing the combination of annotations from the subset and their associated content portions to form one of the clips containing combined content* (paragraph 0016, paragraph 0101)*, and outputting said renderable image containing at least one clip comprising an annotation from the subset with its associated specific content portion, and at least one clip comprising the combination of two or more annotations from the subset with their associated content portions* (paragraph 0078, Figure 9: whereas, the clips are rendered for display)

With regards to claim 23, Keely et al teaches a system for showing clips of content and annotations comprising:

*an input for receiving annotations associated with content* (Figure 1B, reference 170: whereas a stylus can be used for a method of input)*;*

*a processor for creating a renderable image having clips, wherein at least one of said clips is a combination of two or more annotations and their associated content and the associated content will include a user interface to allow various selections* (paragraph 0015, 0016, 0075, and 0078, Figure 9: whereas, clips comprise annotations that are filtered per user input, and the clips can comprise a combination of two or more filtered annotations) *of active* content *change when since the previous renderable image upon*

*the user interface, the active content associated with the annotation has changed* (paragraph 0012: whereas, the content of the document can change/modifiable)*, said processor executing instructions including*
*encompassing first content and an associated annotation in a first region* (paragraph 0091: whereas an asterisk annotation, is associated with a region of content)*,*
*encompassing second content and an associated annotation in a second region, wherein the first and second regions are non-contiguous* (paragraph 0092, Figure 13: whereas another type of annotation/ink is associated with another region of content, the first and second regions of content can be non-contiguous)*, and*
*combining the first region and the second region to form one of said clips based on the active content selection, and an output for outputting said renderable image* (paragraph 0016, 0078, 0101, Figure 9: whereas, the clips are filtered and combined for display).

With regards to claim 2, which depends on claim 23, Keely et al teaches *wherein said at least one of said clips includes additional content* (paragraph 0118: whereas additional data/information can be included with clips).

With regards to claim 5, which depends on claim 23, Keely et al teaches further comprising: *a storage storing said annotation and an image of the first content associated with the annotation* (Figure 8A, Figure 8B: whereas a storage method is implemented).

With regards to claim 6, which depends on claim 23, Keely et al teaches further comprising: *a storage storing said annotations and a link to said content* (Figure 8A, Figure 8B: whereas a storage method is implemented).

With regards to claim 7, which depends on claim 23, Keely et al teaches further comprising: *a storage storing said annotation and an active image of the first content associated with the annotation, wherein the first content changes over time* (paragraph 0012, 0015: whereas, the content of the document can change/modifiable).

With regards to claim 24, which depends on claim 23, Keely et al *teaches wherein prior to combining, the processor executes instructions which determine that the first region and the second region are within a threshold distance from each other in a document, wherein third content without an associated annotation is located in a third region located between the first and second regions content* (paragraph 0016, paragraph 0101: whereas based on proximity, a combination can be performed).

With regards to claim 25, which depends on claim 6, Keely et al teaches *wherein said annotations are from different documents* (paragraph 0062: whereas annotations can be located on different pages/documents).

With regards to claim 26, which depends on claim 25, Keely et al teaches *wherein said documents are from different application programs* (paragraph 0031, 0038, 0040, and

0041: whereas documents can be retrieved from different computers, in a distributed environment).

### *Response to Arguments*

5. Applicant's arguments with respect to claims 6, 7, 9, 10, 13, 15, 16, 19, 21, and 23 - 26 have been considered but are moot in view of the new ground(s) of rejection.

6. Examiner appreciates applicant's willingness to expedite the prosecution of the case. However, via an updated search, Keely et al has been noted to read upon the pending claim language, and is now used to reject the current pending claims.

7. The Examiner is also open to an interview should the applicant desire to request one.

### *Conclusion*

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILSON TSUI whose telephone number is (571)272-7596. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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April 12, 2009